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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/786,104	02/26/2004	Yasutaka Ishii	3273-0185P	4256

2292 7590 01/18/2005

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EXAMINER

NYALLEY, LANSANA

ART UNIT PAPER NUMBER

1621

DATE MAILED: 01/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/786,104	<b>Applicant(s)</b> ISHII ET AL.	
	<b>Examiner</b> Lansana Nyalley	<b>Art Unit</b> 1621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION. ✓

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)                                    | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

1. This application of number 10/768, 104, filed on 02/26/2004, claiming foreign priority of the application of the number 2003-052383 filed on 02/28/2003 is acknowledged.

2. The information disclosure statement filed on the 20<sup>th</sup> of October 2004 is acknowledged.

3. Claims 1-4 are pending.

Claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatented over Lloyd (US patent 1200730).

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

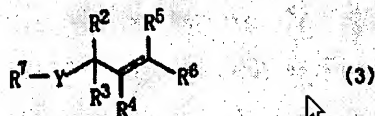
(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

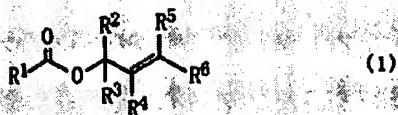
1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

**WHAT APPLICANT CLAIMS.**

1. A process for producing an allyl-containing compound represented by following Formula (3):



wherein  $\text{R}^2$ ,  $\text{R}^3$ ,  $\text{R}^4$ ,  $\text{R}^5$  and  $\text{R}^6$  may be the same as or different from one another and each represent hydrogen atom or an organic group;  $\text{R}^7$  represents an organic group; and Y represents oxygen atom or sulfur atom, the process comprising the step of reacting an allyl ester compound represented by following Formula (1):



wherein  $\text{R}^1$  represents hydrogen atom or an organic group; and  $\text{R}^2$ ,  $\text{R}^3$ ,  $\text{R}^4$ ,  $\text{R}^5$  and  $\text{R}^6$  are as defined above, with a compound represented by following Formula (2):



wherein  $\text{R}^7$  is an organic group; and Y is as defined above, in the presence of at least one transition element compound.

**DETERMINATION OF THE SCOPE AND THE CONTENT OF THE  
PRIOR ART (M.P.E.P. 2141.01).**

Lloyd teaches a process of making an allyl-containing compound by reacting an allyl ester with an alcohol or a mercaptan in the presence of a catalyst elected from the transition elements of group VIII. (Columns 1 lines 10-30 and lines 66-70; column 2, lines 21-36 and lines 50-76, Pages 1-4).

**ASCERTAINMENT OF THE DIFFERENCE BETWEEN THE PRIOR ART  
AND THE CLAIMS (M.P.E.P. 2141.02).**

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Lloyd does not exemplify the specific allyl-containing esters claimed in the Instant application.

FINDING OF PRIMA FACIE OBVIOUSNESS-RATIONAL AND  
MOTIVATION (M.P.E.P. 2142-2143).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have used the alcohol or mercaptan reactants in the process of Lloyd in order to arrive at the products of the instant claims. One of ordinary skill in the art would have been motivated to use any of the reactants disclosed by Lloyd with a reasonable expectation of making compounds which are used to make polymers as well as perfumes.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lansana Nyalley whose telephone number is 571,272,0697. The examiner can normally be reached on 7:45 to 4:45.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 571 272 0646. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Lansana Nyalley, Ph.D.  
12<sup>th</sup> January 2005

  
\_\_\_\_\_  
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